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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1938.

No. 51

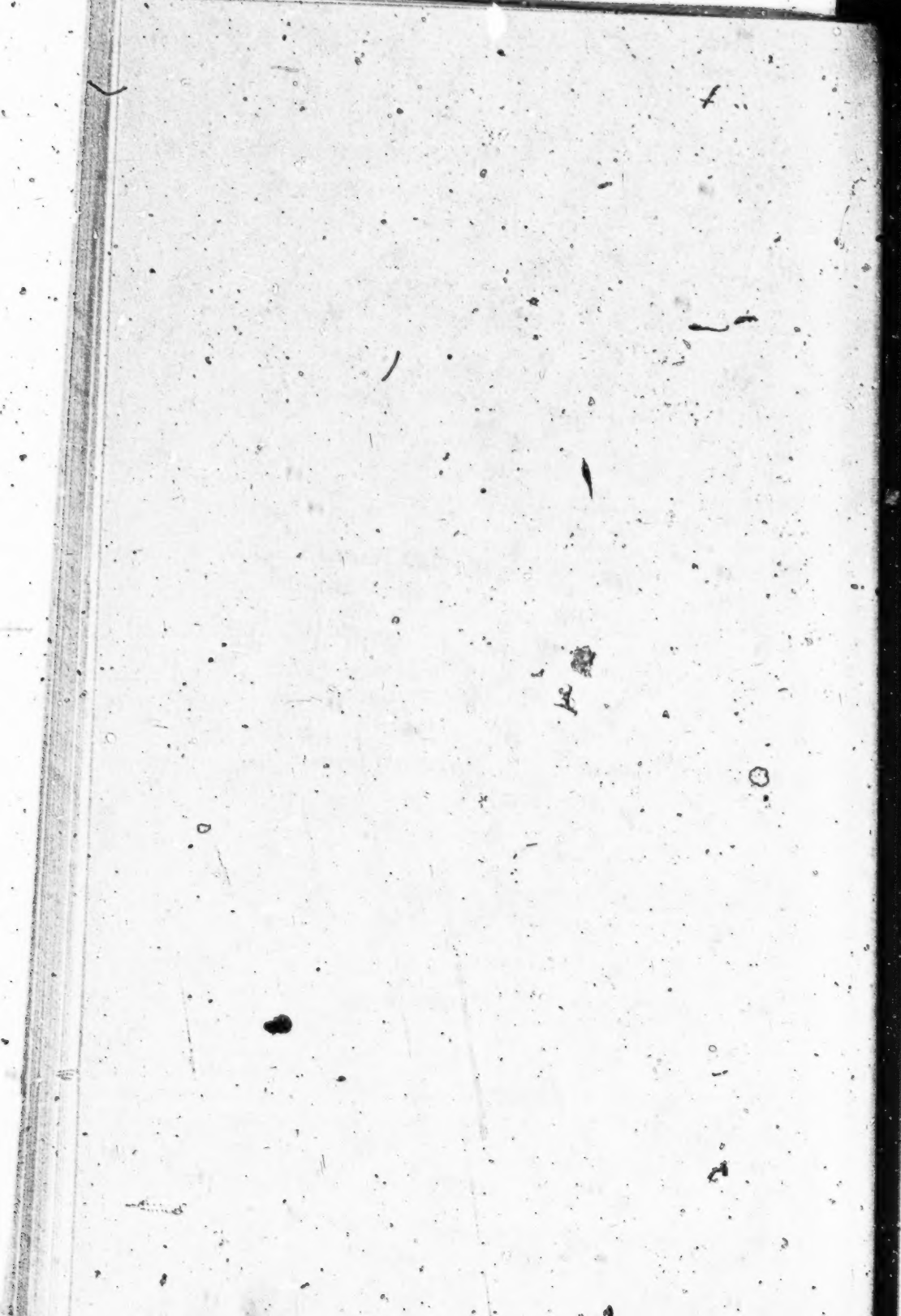
ARMSTRONG PAINT AND VARNISH WORKS,
Petitioner,
vs.

NU-ENAMEL CORPORATION, an Illinois corporation,
and
NU-ENAMEL CORPORATION, a Delaware corporation,
Intervener,
Respondents.

**WRIT OF HABEAS CORPUS TO THE CIRCUIT COURT OF APPEALS
FOR THE SEVENTH CIRCUIT.**

BRIEF OF PETITIONER

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Counsel for Petitioner.



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OCTOBER TERM, A. D. 1938.

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vs.

NU-ENAMEL CORPORATION, an Illinois corporation,
and

NU-ENAMEL CORPORATION, a Delaware corporation,
Intervener,

Respondents.

WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS
FOR THE SEVENTH CIRCUIT.

BRIEF OF PETITIONER*

OPINIONS BELOW.

The District Court did not render a written opinion, but its findings of fact and conclusions of law appear at pages 108 and 109 of the record, and the decree of the District Court appears on page 115 of the record. The opinion of

* Petitioner is sometimes referred to herein as defendant, and Respondent, "Nu-Enamel Corporation," the Illinois corporation, as plaintiff.

the Circuit Court of Appeals for the Seventh Circuit (R. 134) is reported in 95 Fed. (2d) 448. The first opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 81 Fed. (2d) 1.

JURISDICTION.

1. The judgment was rendered in a suit in equity brought under the Trade-Mark Statutes of the United States to determine the issues of the validity and infringement of a Trade-Mark issued under Section 15 U. S. C. A. 121.

2. The Statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, as amended by the act of February 13, 1925; U. S. C. Title 28, Section 347 (a). Petition for certiorari was granted by this Court on October 10, 1938.

STATEMENT OF THE CASE.

The present suit was brought in the District Court of the United States for the Northern District of Illinois, Eastern Division, by Nu-Enamel Corporation, an Illinois corporation, against Armstrong Paint & Varnish Works, an Illinois corporation. The bill of complaint was filed on January 9, 1935. On January 11, 1937, the intervener, Nu-Enamel Corporation, a Delaware corporation, was granted leave to intervene (R. 25). The Bill of Complaint stated at the outset (R. 2), "This is a suit arising under the trade-mark laws of the United States," and charged infringement by defendant* of the plaintiff's alleged trade-mark "Nu-Enamel," registered under the 1920 Trade-Mark Act.

* The Bill of Complaint charged infringement by defendant's use on paints and varnishes of the mark "Nu-Beauty Enamel," although as hereinafter set forth, defendant's mark was "Nu-Beauty," the word "Enamel" having never appeared on any product save the product commonly known as enamel.

The Bill of Complaint did not allege unfair competition, or did it pray for relief against unfair competition.

The District Court held that "Nu-Enamel" is not a valid trade-mark either at common law or under the Trade-Mark Laws of the United States, based upon the following findings of fact by the court (R. 108):

1. Plaintiff and defendant at the time of the filing of the bill of complaint herein were and are now both citizens of the State of Illinois. The intervener, Nu-Enamel Corporation, is a corporation of the State of Delaware.

2. "Nu" in "Nu-Enamel", appearing on plaintiff's label is a phonetic spelling or misspelling of the English word "new" and means "new".

3. "Enamel" is a common English word describing a paint which flows out to a smooth coat when applied and which usually dries with a glossy appearance, and has long been known as such in the paint industry and to the public in general.

4. "Nu-Enamel" used in connection with paint or enamel sold by plaintiff means "new enamel" and is a common and generic term descriptive of the product to which it is applied and of its new or recent origin.

5. "Nu" was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

The District Court stated the following conclusions of law:

1. "Nu-Enamel" is not a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, namely, Trade-Mark Act of March 19, 1920, and Trade-Mark Act of February 20, 1905.

4

2. This Court has jurisdiction to determine the validity of "Nu-Enamel" as a trade-mark under the Trade-Mark Laws of the United States, and having found that "Nu-Enamel" is invalid as a trade-mark, this court has no jurisdiction of the issue of unfair competition or other issues in this case.

Respondents appealed to the Circuit Court of Appeals for the Seventh Circuit which reversed the District Court and held "Nu-Enamel" to be a valid trade-mark.

For further clarification, we call the court's attention to the following proceedings in this matter, which were had before the hearing of this cause on evidence.

The District Court had previously (before answer was filed) dismissed the Bill of Complaint on motion of defendant because of facts appearing on the face of the bill and the exhibits attached thereto (R. 2-11). On appeal, the Circuit Court of Appeals for the Seventh Circuit (81 Fed. (2d) 1) reversed on the following grounds:

"Determination of the question (i. e. the validity of 'Nu-Enamel' as a trade-mark) turns largely upon the use of the word 'Nu' The Court is not justified in assuming, without evidence, that 'Nu' is phonetic spelling of new." (81 Fed. (2d) 1, at page 2.)—(Part in parenthesis ours.)

Defendant then filed its answer (R. 13) and after the hearing which was directed by the Circuit Court of Appeals, the District Court made the findings of fact hereinabove set forth, and again dismissed the bill. Said findings of fact are based on evidence which not only was uncontradicted, but was largely corroborated and furnished by the testimony of plaintiff's witnesses and records of the plaintiff (R. 36; Defendant's Exhibits 60 to 74-B, 86-A to 90-D; R. 101-102, 33, 32, 87).

On appeal from the decree of the District Court, dismissing the bill after hearing, the Circuit Court of Ap-

als, disregarding its first opinion and the directions given therein to the District Court, and absolutely disregarding the uncontradicted findings of fact of the District Court, reversed the District Court and held that "Nu-Enamel" was a valid trade-mark, and that "the conclusion of the District Court that it had no jurisdiction of the issue as to fair competition also was erroneous." (R. 137.)

Thus, this case has been before four courts, twice before the District Court and twice before the Court of Appeals. Twice the District Court decided against the plaintiff. On the first appeal, the Circuit Court of Appeals, in effect, decided that if "Nu" in "Nu-Enamel" meant "new" (as the District Court later found), "Nu-Enamel" was not a valid trade-mark. On the second appeal, the Circuit Court of Appeals found "Nu-Enamel" to be a valid trade-mark in spite of the findings by the District Court that "Nu-Enamel" was descriptive of the product.

Plaintiff's alleged trade-mark (R. 9) covers mixed paints, varnishes, paint enamels, and other kindred products. Plaintiff's application for this trade-mark under the 1905 Trade-Mark Act was refused because the words "Nu-Enamel" were descriptive of the product. Such refusal was acquiesced in by the plaintiff, which then registered the mark under the 1920 Trade-Mark Act (R. 32, Plf.'s Ex. 1).

Petitioner's mark was "Nu-Beauty" or "Armstrong New Beauty" and its products were designated with the species underneath the mark, as follows (R. 41, 72; Defendant's Exhibits 80-85, inc.):

NU-BEAUTY
PAINT

or

ARMSTRONG
NEW BEAUTY
PAINT

NU-BEAUTY
VARNISH

or

ARMSTRONG
NEW BEAUTY
VARNISH

NU-BEAUTY
FURNITURE CREAM

OR

ARMSTRONG
NEW BEAUTY
FURNITURE CREAM

NU-BEAUTY
ENAMEL

OR

ARMSTRONG
NEW BEAUTY
ENAMEL

The record further discloses, without contradiction, that the defendant never used the word "enamel" with its mark "Nu-Beauty" or "Armstrong New Beauty" on any product save the product commonly and generally known as enamel. (R. 41, 72. Def.'s Exs. 80-85 inc.) Plaintiff sells its enamel under its mark "Nu-Enamel" without further or other designation of the product as enamel (R. 7).

Petitioner's business was established in 1854 and has been continuously carried on since that time (R. 71). Its annual sales amount to about four million dollars.

The Nu-Enamel Corporation of Delaware, the intervenor in this cause, was organized in March, 1935 (R. 26) and was not in existence on January 9, 1935, at the time of the filing of the bill of complaint by the Illinois corporation.

SPECIFICATIONS OF ERRORS.

The Circuit Court of Appeals for the Seventh Circuit erred,

1. In disregarding the uncontradicted fact that enamel is the only product on which defendant used the word "enamel" and that enamel is the only product in issue herein.
2. In reversing the decree of the District Court and in holding that "Nu-Enamel" is a valid trade-mark for paints, enamels, etc.

3. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for paints and allied products because it is descriptive of the product.

4. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for the product known as *enamel*, because it is descriptive of enamel.

5. In reversing the positive the finding of fact of the District Court based on uncontradicted evidence that "Nu-Enamel", used in connection with paint or enamel, means "new enamel", and is a common and generic term descriptive of the product to which it is applied.

6. In disregarding entirely the findings of fact of the District Court based on uncontradicted evidence that "nu" was commonly used in the paint and other industries as a phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

7. In considering the issue of unfair competition and other matters not raised by the pleadings, and over which the court had no jurisdiction.

SUMMARY OF ARGUMENT.

1. The Circuit Court of Appeals, in its opinion, has overlooked and disregarded entirely the findings of fact by the District Court, upon which it based its conclusions of law. Such findings of fact were binding on the Circuit Court of Appeals and unassailable, and the Circuit Court of Appeals was without authority to make its own findings.

Adamson v. Gilliland, 242 U. S. 350, 353.

McGaughan v. Real Estate Land, etc., 297 U. S. 606, 608.

In re: Country Club Bldg. Corp., 91 F. (2d) 712, 715.

2. The decision of the Circuit Court of Appeals that "Enamel" is a valid trade-mark is contrary to the trade-mark laws of the United States, under which this was brought, and in conflict with applicable decisions of this court and of other Circuit Courts of Appeals.

A. Descriptive words are not valid as trade-marks under the trade-mark laws of the United States.

Trade-Mark Act, (Section 85, Par. (b), 15 U. S. C. A.).

Trade-Mark Act, (Section 121, 15 U. S. C. A.).

In re: Chas R. Long, Jr., Co. (C. A. D. C.), 280 F. 975, 976.

Standard Paint v. Trinidad, 220 U. S. 446.

Canal v. Clark, 13 Wall. 311.

Elgin Watch v. Illinois Watch, 179 U. S. 665, 673.

Richmond Remedies v. Dr. Miles Medical Co., 16 F. (2) 598, 601.

Kellogg Co. v. National Biscuit, 71 F. (2d) 662, 666.

Rogers on "Good Will, Trade-Marks and Unfair Tradings," (1914 Ed. reprinted 1919) 76.

Charles Broadway Rouss, Inc. v. Winchester Co. 300 F. 706, 712.

- B. That a descriptive word or term has acquired a secondary meaning does not render it capable of being appropriated as a valid trade-mark under the trade-mark laws of the United States.

Elgin Watch v. Illinois Watch, 179 U. S. 665, 677.

Kay & Ess Co. v. Commissioner of Patents, (C. A. D. C.) 92 F. (2d) 552, 554.

In re: Canada Dry Gingerale, Inc. (C. C. P. A.),
86 Fed. (2d) 830, 832, 833.

Speaker v. Shaler, (C. C. A. 7) 86 F. 985, 987.

Barber v. Overhead Door Corporation, (C. C. P.
A.) 65 F. (2d) 147.

Richmond Remedies v. Dr. Miles Medical, (C. C.
A. 8) 16 F. (2d) 598.

Barton v. Rex-Oil Co., (C. C. A. 3) 2 F. (2d) 402,
404.

Hercules Powder v. Newton (C. C. A. 2) 266 F.
169.

Vacuum Oil v. Climax Refining (C. C. A. 6) 120
F. 254.

That "Nu-Enamel" may have acquired a secondary meaning does not prevent others from using such words in their primary descriptive sense as "Nu-Beauty" was used by the defendant in connection with the product known as enamel.

Warner & Co. v. Lilly & Co., 265 U. S. 526, 528.

Pepsi-Cola v. Krause Bottling Co. (C. C. A. 4) 92
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Hygrade, etc. v. W. H. D. Lee, etc. (C. C. A. 10)
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Barton v. Rex-Oil Co., (C. C. A. 3) 2 F. (2d) 402.

Richmond Remedies v. Dr. Miles Medical Co. (C.
C. A. 8) 16 F. (2d) 598.

Fawcett Publications v. Popular Mechanics (C.
C. A. 3) 80 F. (2d) 194, 197.

Standard Paint v. Trinidad, 220 U. S. 446, 462.

O'Cedar Corporation v. F. W. Woolworth, etc.,
66 F. (2d) 363, 366.

4. The Circuit Court of Appeals in its opinion has overlooked and disregarded entirely the finding of fact by the District Court that "Nu" was commonly used in the paint industry as a misspelling of "New" before plaintiff and its predecessors adopted the name "Nu-Enamel," and that enamel was an old and well known product. "Nu" and "Enamel" are, therefore, incapable of being appropriated as a trade-mark.

Columbia Milling v. Alcorn, 150 U. S. 460.

Hanover Milling v. Metcalf, 240 U. S. 403, 415.

Rogers on "Good-Will, Trade-Marks and Unfair Trading" (1914 Ed., reprinted 1919), page 83.

5. There was no issue of unfair competition and the District Court had no jurisdiction over the issue of unfair competition.

- A. The Bill of Complaint contains no allegations of facts constituting unfair competition, nor does it pray for relief against unfair competition.

Garrett v. Louisville & Nashville R. R. Co., 235 U. S. 308, 313.

Crocket v. Lee, 7 Wheat. 522, 527.

- B. There was no diversity of citizenship, and, therefore, no Federal question.

Nu-Enamel v. Armstrong, 81 Fed. (2d) 1, 3, 2.

Atkins v. Gordan, 86 F. (2d) 595.

Leschen Rope Co. v. Broderick Co., 201 U. S. 166, 172.

Hurn v. Oursler, 289 U. S. 238, 248.

Standard Paint v. Trinidad, 220 U. S. 446.

Elgin Watch v. Illinois Watch, 179 U. S. 665, 677.

Van Camp Sea Food Co., Inc. v. Cohn-Hopkins, etc., 56 F. (2d) 797, 799.

Sanders v. Paul, 74 F. (2d) 399, 405.

6. "Nu-Enamel" is not infringed by "Nu-Beauty," or "New Beauty" as used by Petitioner in connection with and on the product known as enamel.

Elliott Varnish Co., v. Sears, Roebuck Co. (C. C.

A. 7) 232 F. 588, 591.

Richmond Remedies v. Dr. Miles Medical Co., 16

F. (2d) 598, 603.

ARGUMENT.

1. The Circuit Court of Appeals, in its opinion, has overlooked and disregarded entirely the findings of fact by the District Court, upon which it based its conclusions of law. Such findings of fact were binding on the Circuit Court of Appeals and unassailable, and the Circuit Court of Appeals was without authority to make its own findings.

A startling feature of the decision of the Circuit Court of Appeals is that no conflict of testimony in the District Court occurred upon which any reversal of fact could possibly be predicated, and that the Court of Appeals, in its opinion, has failed entirely to give cognizance to the findings of fact by the District Court (R. 109) that "Nu" was commonly used in the paint industry prior to the adoption by plaintiff of its trade-mark "Nu-Enamel" and that the word "enamel" describes a paint, and has failed as well to give cognizance to the other findings of fact by the District Court, above set forth (p. 3).

The above findings of fact by the District Court are based on overwhelming evidence, uncontradicted (R. 96-99, 76, 77) (Def's. Ex. 39). The record discloses the common use of "Nu" in the paint industry long before plaintiff adopted the mark "Nu-Enamel". The word "enamel" is notoriously as old as the paint industry itself. These findings of fact by the District Court are under the principles laid down by this court in *Adamson v. Gilliland*, 242 U. S. 350, 353, and *McGaughn v. Real Estate Land, Title and Trust Co.*, 297 U. S. 606, 608, unassailable, and conclusive on the Circuit Court of Appeals.

In the *Adamson* case this court said, page 13:

"The case is preeminently one for the application of the practical rule that so far as the finding of the Master or Judge who saw the witnesses 'depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' *Davis v. Schwartz*, 155 U. S. 631, 636."

This principle was recognized by the Circuit Court of Appeals for the Seventh Circuit in the case of *In re Country Club Building Corporation*, 91 F. (2d) 713, where the court said (p. 715):

"It is not the province of this court to weigh the evidence or analyze the same except to the extent of ascertaining if the ultimate fact found by the trial court is supported by any evidence. The rule is succinctly stated in *McGaughn v. Real Estate Land Title & Trust Co.*, 297 U. S. 606, on page 608:

"The ultimate question for the decision of the trial court was one of fact and its general verdict was conclusive. The Circuit Court of Appeals was without authority to weigh the evidence and to make its own findings."

2. The decision of the Circuit Court of Appeals that "Nu-Enamel" is a valid trade-mark is contrary to the trade-mark laws of the United States, under which this suit was brought, and in conflict with applicable decisions of this court and of other Circuit Courts of Appeals.

A. Descriptive words are not valid as trade-marks under the trade-mark laws of the United States.

We are not concerned in this case with any product either of plaintiff or defendant other than the product commonly known as enamel. *Enamel is the only product in issue.* (R. 41, 72.)

The question in this case is whether "Nu-Enamel", which the District Court found from uncontradicted evidence to mean "new enamel" and, therefore, descriptive of the product known as enamel, can be the subject of a valid trade-mark under the Trade-Mark Laws of the United States.

The first section of the Trade-Mark Act of March 19, 1920 (Section 121, Chapter 3, Title 15, Code of Laws of the United States of America) (15 U. S. C. A. 121), under which "Nu-Enamel" was registered, provides:

"The Commissioner of Patents shall keep a register of . . . (b) all other marks not registerable under the preceding subdivision of this chapter, except those specified in Paragraphs (a) and (b) of Section 85 of this chapter."

Paragraph (b) of Section 85, (15 U. S. C. A. Sec. 85), provides that:

"No mark which consists . . . merely in words or devices which are descriptive of the goods with which they are used . . . shall be registered."

The Circuit Court of Appeals in its opinion, however, overlooked and disregarded the fact that the only product involved in this case is enamel. In discussing the ques-

* In *re Ohas. R. Long, Jr., Co.*, 280 Fed. 975 (C. A. D. C.) involving the word "Stabrite" as applied to a polish for locomotives, the court said in passing upon the interpretation of said Act (976):

"In his reply brief and in his argument at bar, however, appellant has contended that his rights are enlarged by the Act of March 19, 1920 (41 Stat. 533), 'to give effect to certain provisions of the convention for the protection of trade-marks and commercial names, made or signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910.' But paragraph 'b' of section 1 of that act, particularly relied upon by appellant, excepts from its operation marks specified in Paragraphs 'a' and 'b' of section 5 of the Trade-Mark Act of February 20, 1905 (33 Stat. 724 (Comp. St. No. 9490)). Under paragraph (b) of the Trade-Mark Act, a mark consisting 'merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods,' may not be registered. The act of 1920, therefore does not change the status of appellant here."

tion as to whether or not "Nu-Enamel" is descriptive, the court refers to products other than enamel, entirely ignoring enamel, the only product in issue.

Said the Circuit Court of Appeals in its opinion (R. 135):

"It is contended by defendant that the mark 'Nu-Enamel' cannot be the subject matter of a valid trade-mark for the reason that it is descriptive in character, and the District Court so found. We cannot agree. The word 'Nu-Enamel' as applied to paints, paint brushes, solder, wax and similar products is in no wise descriptive of the subject matter or of the possibility of results of use of the products."

In respect to the question of descriptiveness of the plaintiff's mark "Nu-Enamel," it may be a good trade-mark for brushes, wood powder, wax, varnish remover, solder and tack rags, but "Nu-Enamel" is descriptive of *new enamel*, whether "new" be spelled "nu" or "new". "*New Tack Rags*" might be non-descriptive and a good trade-mark for new enamel, but it would be descriptive of *new tack rags* and invalid as a trade-mark for such *rags*. The conclusion of the Circuit Court of Appeals that the words "Nu-Enamel" are not descriptive of many articles (listed above) other than enamel, upon which Respondent uses them is not a sound basis for the further conclusion that therefore Nu-Enamel does not describe *new enamel*.

The District Court, however, basing its conclusion on the findings of fact, hereinabove set out (page 3), that "Nu-Enamel" was descriptive of the product, properly concluded that it was invalid as a trade-mark, both under the Trade Mark Laws of the United States and under the common law.

That words like Nu-Enamel, descriptive of the product with which they are used, even when misspelled, are not the subject of a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, is so fundamental that it scarcely requires the citation of authorities.* We refer to the oft cited and quoted cases, *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, involving the misspelled word "Rubberoid"; *Canal Co. v. Clark*, 13 Wall., 311; *Elgin Watch Co. v. Illinois Watch Co.*, 179 U. S. 665. In the latter case, this court said (673):

"... * * it follows that no sign or form of words can be appropriated as a valid trade-mark which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."

In *Richmond Remedies Co. v. Dr. Miles Medical Co.*, 16 Fed. (2d) 598 (C. C. A. 8), the court said (601):

"The word 'Nervine' is a descriptive word, meaning a nerve tonic, or a remedy for disorders of the nerves. The court will take judicial notice that it has been in use for more than a century and a half. It is a part of the public heritage. Being a descriptive word, it cannot be appropriated as a trade-mark at common law, either alone or in combination with the word 'Samaritan'."

"Nor can it be registered under the federal statute relating to trade-marks, unless it meets the requirement of the fourth proviso of section 5(b) of

* In his book "Good Will, Trade Marks and Unfair Trading" (1914—reprinted 1919), Mr. Edward S. Rogers says (p. 76):

"DON'T SELECT A DESCRIPTIVE NAME"

"A descriptive name is less distinctive even than a geographical or personal name. * * * This would seem to be so evident that discussion of it is not necessary, but when one sees the advertising pages of magazines and the bill boards plastered with names which are descriptive or only thinly disguised descriptions with idiot attempts made to cover their descriptiveness by misspelling, it makes one feel that almost anything in foolishness is possible. Misspelling does not help at all." (The italics are ours.)

the Act of February 20, 1905 (33 Stat. 724 (Comp. St. No. 9490).)''

Descriptive words like "Nu-Enamel" are not registrable under the Trade-Mark Act of February 20, 1905, and the same prohibition against the registration of descriptive words or devices was adopted specifically by reference in the Trade-Mark Act of March 19, 1920. Therefore, the attempted registration of the trade-mark "Nu-Enamel" by the plaintiff is of no validity, and plaintiff acquired no right to said trade-mark under said act. Registration under the Trade-Mark Act of 1920 is not even *prima facie* evidence of the ownership of "Nu-Enamel" as a trade-mark. As the court said in *Kellogg Co. v. National Biscuit Co.*, 71 Fed. (2d) 662 (C. C. A. 2), (666):

"While it is true that a registered trade-mark cannot be cancelled except by direct attack in the way prescribed by the statute, trade-marks registered under the Law of 1920 (Act Congress March 19, 1920, 41 Stat. 532) (15 U. S. C. A. Par. 121 *et seq.*) as those in question were, are not thereby rendered valid. Their validity may still be questioned in any suit in which they are relied upon. That act was for the purpose of enabling persons in this country to register trade-marks so that they might obtain registration under the laws of foreign countries. As we said in *Charles Broadway Rouss v. Winchester Co.*, 300 Fed. 706, it has no effect on the domestic rights of the person whose trade-mark is registered. In short, the registration cannot in itself determine any of the issues involved in the present case."

As the court said in *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 Fed. 706 (C. C. A. 2), at page 712:

"Whatever may be the rights of the plaintiff acquired by its registration of the words 'The Winchester,' and the act of 1920, we are satisfied that it did not obtain thereby even a *prima facie* title to the words as a trade-mark or trade-name."

MICROCARD

TRADE MARK



22



MICROCARD
EDITIONS, INC.

PUBLISHER OF ORIGINAL AND REPRINT MATERIALS ON MICROCARD AND MICROFICHES
901 TWENTY-SIXTH STREET, N.W., WASHINGTON, D.C. 20037, PHONE (202) 333-6393

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- B. That a descriptive word or term has acquired a secondary meaning does not render it capable of being appropriated as a valid trade-mark under the trade-mark laws of the United States.

This question was decided in *Elgin Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, where this court in language unusually applicable and pertinent hereto, said (p. 677):

"It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing, or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trade mark? If the absolute right to the word as a trade mark belonged to appellant, then the Circuit Court had jurisdiction under the statute to award relief for infringement; but if it were not a lawfully registered trade mark, then the Circuit Court of Appeals correctly held that jurisdiction could not be maintained.*

"And since while the secondary signification attributed to its use of the word might entitle appellant to relief, the fact that primarily it simply described the place of manufacture, and that appellees had the right to use it in that sense, though not the right to use it, without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that *this geographical name could not be employed as a trade mark and its exclusive use vested in appellant, and that it was not properly entitled to be registered as such.*" (Italics ours.)

*As the District Court herein held in its Conclusions of Law. (R. 109.)

The *Elgin Watch* case has been uniformly followed by the various Circuit Courts of Appeals.**

In the recent case of *Kay & Ess Co. v. Commissioner of Patents*, 92 Fed. (2d) 552 (C. A. D. C.), it appeared that the word "Morocco" described certain type of paints, enamels, varnishes, lacquers and japans. It also appeared from the evidence that the term "Morocco" as used in the trade, identified the product made by appellant. The court said (p. 554):

"In respect of the appellants point that a descriptive word is registerable if it has acquired a secondary meaning: the law is settled that while a secondary meaning may be protected in equity against fraudulent or descriptive use, the existence of a secondary meaning is not a foundation for the registration of a descriptive word."

In *Barton v. Rex-Oil Co.*, (C. C. A. 3), 2 F. (2d) 402, the Court said (404):

"A merely descriptive name can never become such property, *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, and the utmost the first user of such a name after it has acquired a secondary meaning can insist upon is that no one shall use it against him in an unfair way."

It was contended in the above case that "Dyanshine" was the subject of a valid trade-mark, but the Court held otherwise, and said (404):

"The word 'Dyanshine' is merely descriptive of the characteristics of the product, and therefore this

**In *re Canada Dry Gingerale, Inc.* (C. C. P. A.) 86 Fed. (2d) 830, in which the *Elgin* case and other cases covering this question are reviewed at length; *Kay & Ess Co. v. Com* (C. A. D. C.) 92 Fed. (2d) 552; *Speaker v. Shaler*, (C. C. A. 7) 86 Fed. (2d) 985; *Barber v. Overhead Door Corporation* (C. C. P. A.) 65 Fed. (2d) 147; *Richmond Remedies v. Dr. Miles Medical* (C. C. A. 8) 16 Fed. (2d) 598; *Barton v. Rex Oil Co.* (C. C. A. 3) 2 Fed. (2d) 402; *Hercules Powder v. Newton* (C. C. A. 2) 266 Fed. 169; *Vacuum Oil v. Cumar Refining* (C. C. A. 6) 120 Fed. 254.

word, a collection of several words misspelled, is not a subject-matter of a valid trade-mark. We are in accord with the finding of the learned trial court that the registration is invalid."

In *In re Canada Dry Gingerale, Inc.* (C. C. P. A.) 86 F. (2) 830, it was contended that "Canada Dry," even though it was a geographic and descriptive term, having acquired a secondary meaning, was the subject of a valid trade-mark. The Court, however, held otherwise, and (quoting from its opinion in *Barber v. Overhead Door Corporation*, 65 F. (2d) 147) said (832):

"The decision of the Supreme Court of the United States in the case of *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, is unusually pertinent to the facts at bar and the contentions of appellee. The court there held that words which were merely descriptive of the place where the articles were manufactured could not be monopolized as a trade-mark, and that the word 'Elgin' was such a term, and that, if it had acquired a secondary meaning in connection with its use, protection from imposition and fraud would be afforded by the courts, but that, *notwithstanding this fact, its descriptive or geographic character rendered it unregistrable as a trade-mark.*" (Italics ours.)

And also (quoting from *Hercules Powder Co. v. Newton*, (C. C. A.) 266 F. 169), said (833):

"It is not possible under the present act for a citizen to choose as his trade-mark something invalid by general law, use it without opposition long enough to make a showing of trade repute and commercial success, derive from that success 'secondary meaning' for his mark, and then apply for registration."

With reference to the "Canada Dry" label in question, the Court said (833):

"Inasmuch as the Supreme Court of the United States has directly held that a geographical term which

was descriptive of the place where the articles were manufactured was not registerable even though it had acquired a secondary meaning, we must follow our decision in the *Overhead Door Case*, *supra*, which is in harmony with the views of the Supreme Court."

In *Speaker v. Shaler*, (C. C. A. 7) 86 F. (2d) 985, Judge Lindley said with reference to the doctrine of secondary meaning as applied to the mark "Hot Patches," (987):

"The relief, however, is not granted under the rules applicable to infringement of a trade-mark."

The Circuit Court of Appeals, however, in this case, contrary to the above decisions of this Court and of other Circuit Courts of Appeals (including the Circuit Court of Appeals for the Seventh Circuit in the case of *Speaker v. Shaler*, 86 Fed. (2d) 985, 987), has held that because "Nu-Enamel" had acquired a secondary meaning it thereby attained validity as a trade-mark, even though descriptive of the products to which it is applied. The admission by defendant in Paragraph 2 of its answer (R. 13) and referred to in the opinion of the court below (R. 134), is an admission only that "Nu-Enamel" had acquired a secondary meaning as a trade name. Such an admission did not and can not give it validity as a *statutory trade-mark*. Under the prohibitions of the Trade-Mark Laws of the United States, and under the applicable decisions of this and other Federal Courts, it is incapable of being a valid trade-mark.

3. That "Nu-Enamel" may have acquired a secondary meaning does not prevent others from using such words in their primary descriptive sense as "Nu-Beauty" was used by the defendant in connection with the product known as enamel.

As heretofore pointed out the only product on which defendant ever used the word "enamel" in connection

with its mark "Nu-Beauty" or "Armstrong New Beauty" was the product known as *enamel*. On no other product did defendant use the word "enamel" in connection with its mark "Nu-Beauty" (or "Armstrong New Beauty"). The language of this court in *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528, is pertinent:

"We agree with the courts below that the charge of infringement was not sustained. The name *Coco-Quinine* is descriptive of the ingredients which enter into the preparation. The same is equally true of the name *Quin-Coco*. A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade mark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product."

The principle emphasized in the *Warner* case has been reiterated in numerous cases by various Circuit Courts of Appeal.*

In *Pepsi-Cola Co. v. Krause Bottling Co.*, (C. C. A. 4) 92 Fed. 2nd, 272, at page 274, the Court quoting from *Bliss v. Arleen*, (C. C. A. 4) 25 Fed. 2nd, 370, at 372 said:

"It is settled beyond all controversy that a manufacturer has no right to the exclusive use of a descriptive word in connection with his goods, and if nevertheless he adopts such a trade-mark, he himself is largely to blame for the confusion which ensues when other manufacturers, with equal right, adopt similar terms to describe their products."

**Hygrade, etc. v. H. D. Lee, etc.*, (C. C. A. 10) 46 F. (2d) 771, 772; *Barton v. Rex-Oil Co.*, (C. C. A. 3) 2 F. (2d) 402; *Richmond Remedies v. Dr. Miles Medical Co.*, (C. C. A. 8) 16 F. (2d) 598; *Fawcett Publications v. Popular Mechanics*, (C. C. A. 3) 80 F. (2d) 194; *Pepsi-Cola Co. v. Krause Bottling Co.*, (C. C. A. 4) 92 F. (2d) 272, 274.

In *Fawcett Publications v. Popular Mechanics*, (C. C. 3) 80 F. (2d) 194, the Court said (197):

"It is easy to forget that it is not competition but unfair competition which entitles the user of a descriptive word with an acquired secondary meaning, to relief. Such a word belongs to the public in its primary sense."

The Circuit Court of Appeals for the Seventh Circuit *O'Cedar Corporation v. F. W. Woolworth, etc.*, 66 F. (2d) 363 (C. C. A. 7), said even of a validly registered trade-mark "O'Cedar" (366):

"A recognition of the validity of the trade-marks does not give appellant a monopoly of the word 'Cedar'." . . .

(P. 367):

"That appellant acquired no exclusive right to use the words 'cedar' or 'cedar oil' as applied to polish must be readily conceded."

It is submitted that to deny to this Petitioner, a company in existence since 1854, (B. 71) the right to sell its enamel *enamel*, stretches trade-mark law beyond its elastic limits. Yet this is the result of the Court's opinion, for the defendant is permitted to sell Nu- (or Armstrong New) beauty varnish, paint, and furniture polish, but not enamel. The Circuit Court of Appeals in effect has held that on every species of the class, except enamel, there is no infringement. In other words, the use of the name of the species, *enamel*, in its primary and descriptive sense on *enamel* only,—the only name by which the species known in the industry,—spells infringement.

This Court in affirming the opinion of the Circuit Court of Appeals said in *Standard Paint Co. v. Trinidad Asphalt*, 220 U. S. 446, 462:

"The only imitation by the Asphalt Company of the roofing of the Paint Company is that which exists in the use of the word 'rubbero', and this only by its asserted resemblance to the word 'ruberoid'. To preclude its use because of such resemblance would be to give to the word 'ruberoid' the full effect of a trade-mark, while denying its validity as such."

4. The Circuit Court of Appeals in its opinion has overlooked and disregarded entirely the finding of fact by the District Court that "Nu" was commonly used in the paint industry as a misspelling of "New" before plaintiff and its predecessors adopted the name "Nu-Enamel," and that enamel was an old and well known product. "Nu" and "Enamel" are, therefore, incapable of being appropriated as a trade-mark.

The District Court made the following finding of facts (R. 109):

"5. 'Nu' was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of 'new' to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name 'Nu-Enamel'."

As heretofore pointed out, the above finding of facts by the District Court is based on overwhelming evidence, uncontradicted (R. 96-99, 76, 77) (Def.'s. Ex. 39). The record discloses the common use of "Nu" in the paint industry long before plaintiff adopted the mark "Nu-Enamel" (R. 96-98, Def.'s. Ex. 101-128, R. 76-77, R. 17, Def.'s. Ex. 39). The word "enamel" is notoriously as old as the paint industry itself.

"Nu" and "enamel," therefore, having been used for many years in the paint industry in connection with

paint and enamels, are incapable of being appropriated and monopolized as a trade-mark. This court so held in *Columbia Mill v. Alcorn*, 150 U. S. 460, and *Hanover Milling Co. v. Metcalf*, 240 U. S. 403, at page 415, where the Court said:

"Of course, if the symbol or device is already in general use, employed in such a manner that its adoption as an index of source or origin would only produce confusion and mislead the public, it is not susceptible of adoption as a trade-mark. Such a case was *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 464, affirming 40 Fed. Rep. 676, where it appeared that before complainant's adoption of the disputed word as a brand for its flour the same word was used for the like purpose by numerous mills in different parts of the country."

It is a rule recognized by Rogers, in his book "Good Will, Trade-Marks and Unfair Trading," (1914, reprinted 1919), at page 83.*

How extensive was the use of "Nu" in the paint industry as a misspelling of "New" may be conveniently noted from examples taken from the record and set forth in Appendix A to this brief.

There was no issue of unfair competition and the District Court had no jurisdiction over the issue of unfair competition.

A. The Bill of Complaint contains no allegations of facts constituting unfair competition, nor does it pray for relief against unfair competition.

The issue of unfair competition is not involved herein, and the District Court properly refused to assume juris-

*"The courts do not protect a trader in the use of things which are common to the trade, because being common to the trade, they cannot indicate commercial origin with any one producer."

diction of the issue of unfair competition for the reason that the Bill of Complaint herein does not raise the issue of unfair competition nor does it allege facts from which unfair competition can reasonably be inferred.

The bill of complaint states as a preface (R. 2): "This is a suit arising under the trade-mark laws of the United States." The only charge in the Bill of Complaint (R. 2 to 5) is that the use by defendant of "Nu-Beauty Enamel" constitutes an infringement of plaintiff's registered trade-mark "Nu-Enamel." *No other act or acts whatsoever are charged or alleged.* Proof of any other acts was clearly incompetent, *and proof, if any, of any other facts or acts could not be the basis for a finding or decree.* Nowhere in the Bill of Complaint is there any allegation or charge of unfair competition or any words which might be construed as allegations of unfair competition by the defendant.

The prayer in the Bill of Complaint merely asks that defendant be enjoined from "*infringing plaintiff's registered trade-mark.*"

The District Court, having found that "Nu-Enamel" is not a valid trade-mark either at common law or under the trade-mark laws of the United States, rightfully concluded as a matter of law that it had no jurisdiction of the issue of unfair competition or other issues in this case, not alleged or set out in the Bill of Complaint.

Plaintiff's case must stand or fall on the issues made by the pleading, and not having charged in its Bill of Complaint any acts of unfair competition, but having limited its Complaint solely to the allegation of an infringement by defendant's label of an alleged trade-mark which the Court found to be invalid, there was nothing left before the Court on any issues outside of the allegations in the Bill of Complaint.

In *Garrett, Administrator of Lewis v. Louisville & Nashville Railroad Company*, 235 U. S. 308, this Court said (313):

"Although the same precision of statement is not required as in pleadings at law, nevertheless it is held to be absolutely necessary that in bills of equity such a convenient degree of certainty should be adopted as may serve to give the defendant full information of the case which he is called upon to answer. Every bill must contain in itself sufficient matters of fact, *per se*, to maintain the plaintiff's case; and if the proofs go to matters not set up therein, the court cannot judicially act upon them as a ground for decision, for the pleadings do not put them in contestation. *Harrison v. Nixon*, 9 Pet. 483, 503; *Daniell's Ch. Pl. & Pr.* 368." (Italics ours.)

In *Crocket v. Lee*, 7 Wheaton, 522, Chief Justice Marshall said (527):

"If the pleadings in the cause were to give no notice to the parties or to the Court of the material facts on which the right asserted was to depend, no notice of the points to which the testimony was to be directed, and to which it was to be limited; if a new case might be made out in proof, differing from that stated in the pleadings, all will perceive the confusion and uncertainty which would attend legal proceedings, and the injustice which must frequently take place. The Rule that the decree must conform to the allegations, as well as to the proofs of the parties, is not only one which justice requires, but one which necessity imposes on courts. We cannot dispense with it in this case."

The Circuit Court of Appeals, in its opinion herein, has disregarded the above principles and rules in relation to the issue of unfair competition, *allegations as to which nowhere appear in the bill of complaint herein.*

B. There was no diversity of citizenship, and, therefore, no Federal question.

As we have heretofore pointed out under 5-a, the issue of unfair competition is not involved in this case. However, even if it had been raised by the Bill of Complaint, "Nu-Enamel" not being a valid trade-mark under the laws of the United States, and there being no diversity of citizenship at the time of the filing of the bill herein, the District Court had no jurisdiction over the issue of unfair competition.

When this case was before the Circuit Court of Appeals on appeal from the order dismissing the Bill of Complaint, the court (*Nu-Enamel v. Armstrong*, 81 F. (2d) 1), said (3):

"We have no doubt but that the so-called unfair competition phase of the case may be heard with the trade-mark infringement charge, *provided the trade-mark be held valid.*" (*Italics ours.*)

and (2):

"The court is not justified in assuming without evidence that 'Nu' is phonetic spelling of 'New'."

In effect, the Circuit Court of Appeals held that if "Nu" meant "New," the bill was properly dismissed in the first proceedings. This case was sent back for the purpose of taking evidence on the meaning of the word "Nu" and the evidence having clearly established that "Nu" means "New," the District Court properly held that "Nu-Enamel", is not a valid trade-mark. *Therefore, the trade-mark being invalid, and there being no diversity of citizenship at the time of the filing of the bill of complaint and no Federal question involved, the court had no jurisdiction over the non-Federal question of unfair competition, even if that issue had been raised by the pleadings.*

The question of jurisdiction in a situation such as this was again before the Circuit Court of Appeals for the Seventh Circuit in *Atkins v. Gordon*, 86 F.2d 595 (decided November 30, 1936), involving the alleged infringement of plaintiff's patent, and the court having held that the patent of plaintiff was invalid, said (Mr. Justice Evans) (597):

"We are of the opinion that the single claim of the patent is invalid for want of patentable novelty.

It is unnecessary to discuss the unfair trade method charges, for in view of the residence of the parties in the same state, the Federal court's jurisdiction is dependent upon appellee's sustaining the patent infringement charge of the complaint."

In *Leschen Rope Co. v. Broderick*, 201 U. S. 166, involving, as does this case, an invalid trade-mark, this court said (172):

"Nor can we assume jurisdiction of this case as one wherein the defendant had made use of plaintiff's device for the purpose of defrauding the plaintiff and palming off its goods upon the public as of the plaintiff's manufacture. Our jurisdiction depends solely upon the question whether plaintiff has a registered trade-mark valid under the act of Congress, and, for the reasons above given, we think it has not."

The *Leschen Rope* case was approved and followed in *Standard Paint v. Trinidad*, 220 U. S. 446. The same rule was laid down in *Elgin Watch v. Illinois Watch*, 199 U. S. 665, where this Court said (p. 677):

"but if it were not a lawfully registered trade mark, then the Circuit Court of Appeals correctly held that jurisdiction could not be maintained."

We quote in full that part of the opinion of this Court in *Hurn v. Oursler*, pertaining to the *uncopyrighted*

portion of the play in question in that case, which we submit is pertinent to the case at bar, involving as it does an invalid trade-mark (*Hura v. Oursler*, 289 U. S. 238, 248):

"Two. During the pendency of the suit petitioners amended their bill so as to make its allegations apply to the uncopyrighted version of their play, namely, that the wrongful acts of respondents were in violation of the rights of petitioners and constituted unfair business practices and unfair competition with respect to that version as well as to the original. *Since that claim did not rest upon any Federal ground and was wholly independent of the claim of copyright infringement, the district court was clearly right in dismissing it for want of jurisdiction.* The bill as amended, although badly drawn, sets forth facts alleged to be in violation of two distinct rights, namely, the right to the protection of the copyrighted play, and the right to the protection of the uncopyrighted play. From these averments two separate and distinct causes of action resulted, one arising under a law of the United States, and the other arising under general law. For reasons that have already been made manifest, the latter is entirely outside the Federal jurisdiction and subject to dismissal at any stage of the case. *It is hardly necessary to say that a Federal court is without the judicial power to entertain a cause of action not within its jurisdiction, merely because that cause of action has mistakenly been joined in the complaint with another which is within its jurisdiction.*" (Italics ours.)

In *Van Camp Sea Food Co. Inc. v. Cohn-Hopkins, etc.*, 56 F. (2d) 797 (C. C. A. 9) (petition for writ of certiorari denied, 286 U. S. 561), the Court said (799):

"In each of the cases now under consideration, the appellant not only alleges infringement of trade-mark, but also alleges unfair competition. Jurisdiction in every case but one is predicated upon in-

fringement of trade-mark, there being no diversity of citizenship, and our decision that the trade-mark is invalid precludes further consideration of the question of unfair competition for lack of jurisdiction."

The belated intervention in this case of the Nuamel Company, the Delaware corporation, organized after the filing of the bill of complaint herein, cannot in any way affect the jurisdiction of this court which is dependent upon the state of facts as they existed at the time the suit was commenced.

Equity Rule 37 of the Supreme Court of the United States, provides:

"Anyone claiming an interest in the litigation may at any time be permitted to assert his right by intervention, but the intervention shall be in subordination to, and in recognition of, the propriety of the main proceedings."

The plaintiff and defendant in the main proceedings are Illinois corporations. Clearly, if the main proceedings could not properly have been brought in the Federal court, the subsequent intervention by a citizen of another state can in no way affect the jurisdiction. As the Court held in the case of *Sanders v. Paul* (C. C. A. 10), 74 F. 399, 405:

"The test of the jurisdiction is the citizenship of the indispensable parties at the time when the suit was commenced and jurisdiction is not affected by the subsequent change of the parties."

It is clearly the law and within the intent and purview of Rule 37 which recognizes, and is merely a re-statement of the law in the effect of intervention.

6. "Nu-Enamel" is not infringed by "Nu-Beauty", or "New Beauty" as used by Petitioner in connection with and on the product known as enamel.

An examination of Exhibit C attached to the bill of complaint (R. 11) and the cans of enamel and labels of Petitioner in evidence, discloses that Petitioner's mark on cans of enamel was not "Nu-Enamel" with the word "Beauty" inserted between the words "Nu" and "Enamel" but that "*Nu-Beauty*" is a separate word in a different script and on a different line from the word "*Enamel*," and with the words "Superfine" on another line below "Nu-Beauty" and above "Enamel."

The label on Petitioner's cans of enamel is not at all confusingly similar to or an imitation of the label on Respondent's cans of enamel.

Neither "Nu-Beauty" nor "New Beauty" is similar in appearance to "Nu-Enamel."

Phonetically the two words, even in connection with the word "Enamel," are different.

The words have different meanings. "Nu-Enamel" conveys to the mind of the purchaser the idea that the product is an improved or new enamel. "Nu-Beauty" (New Beauty) conveys to the mind of the purchaser the idea that, when the enamel is applied to an article, that article will acquire a new beauty.

The words "Nu-Enamel" on Respondents' label, and the words "Nu-Beauty" or "New Beauty" on Petitioner's label are printed differently. "Nu-Enamel" on Respondents' label is in blocked letters, arched at the bottom, with a red rectangle containing three legends appearing prominently under the word "Nu-Enamel." "Nu-Beauty" on Petitioner's label is in script, is at an angle, is enclosed in an elliptical design, and the word "Enamel" appears

below the words "Nu-Beauty" with the word "Super-
me" between the two on another line.

The name "Armstrong" and "Armstrong Paint &
Varnish Works, Chicago" appear prominently on Peti-
tioner's labels.

The set-up, design and color of Petitioner's label are
entirely different from that of the label of Respondents.

The predominant colors of Respondent's label and can
are red and yellow. The predominant color on Peti-
tioner's label are black, white and silver.

In *Elliott Varnish Co. v. Sears Roebuck Co.*, 232 F..
88 (C. C. A. 7), involving the words "Never Leak"
and "Roof Leak" on roofing cement, the Court said
(191):

"The labels are not so similar as to deceive the
ordinary purchaser."

In *Richmond Remedies Co. v. Dr. Miles Medical Co.*,
F. (2d) 598, the Court after analyzing the differences
between plaintiff's and defendant's labels, said (603):

"The words of Mr. Justice Brewer in the case of
P. Lorillard Co. v. Peper, *supra*, are quite apposite
here:

"The difference is such that the eye will take it in
at a moment's glance. Summing it all up, while
there are certain minor points of resemblance which
have been forcibly urged upon our attention by
the counsel for plaintiff, yet, looking at the two
packages with their labels, taking the tout ensemble,
it appears to us clear that they are so essentially
different that no one of ordinary intelligence, de-
siring to buy the one kind of tobacco, would be
misled into buying a package of the other. * * * We
cannot surrender our own judgment in this matter
because others may be of a different opinion, or be-
cause it happens in isolated instances, that some pur-

chaser was so careless as not to detect the difference. It may well be that, where many sales were made, some individuals, not particularly attentive, may have purchased the defendant's supposing they were purchasing the plaintiff's package. Such things will happen in the ordinary course of business, no matter how great the differences; and the fact that they do happen, while it is not to be ignored, is not to outweigh the evidence which comes from a personal inspection of the packages and labels'." (Italics ours.)

An inspection of Petitioner's and Respondents' cans and labels clearly discloses that he would have to be an extremely careless person and color-blind, who would mistake and confuse the two. We submit that Petitioner's cans of enamel bear no greater resemblance to Respondents' cans, than do other cylindrical cans of enamel of the same size which may bear on their labels the word "enamel." If there are any isolated instances of confusion, as the Court said in *Richmond Remedies Co. v. Dr. Miles Medical Co.* "such things will happen in the ordinary course of business, no matter how great the difference is."

This obvious lack of confusing similarity between the two labels manifest from an inspection of Exhibits "A" and "C" attached to the bill of complaint (R. 7 and 11) of itself furnishes justification for the District Court's original dismissal of the bill of complaint before an answer was filed herein.

CONCLUSION.

From the foregoing it appears that the Circuit Court of Appeals for the Seventh Circuit has now rendered a decision in conflict with its own previous decision, in conflict with the findings of facts and decision of the trial court, in conflict with the controlling and applicable decisions of this court, in conflict with applicable decisions of various Circuit Courts of Appeals (including decisions of the Circuit Court of Appeals for the Seventh Circuit) in a case of great public, economic and industrial importance, and which decision has seriously prejudiced not only the rights of petitioner, but of other paint manufacturers and dealers. We respectfully submit that if "Nu-Enamel" (or, "New Enamel") is non-descriptive, and therefore, is a valid trade-mark for the product known as *enamel*, then "Auld Enamel" (or "Old Enamel") is equally non-descriptive and a valid trade-mark for the product known as *enamel*.

We therefore urge that for the reasons hereinabove set forth, the Circuit Court of Appeals for the Seventh Circuit committed error, and that, therefore, the decision of the Circuit Court of Appeals should be reversed and the decree of the District Court should be affirmed.

Respectfully submitted,

GEORGE A. CARPENTER,

GEORGE I. HAIGHT,

MOSES LEVITAN,

Counsel for Petitioner.

APPENDIX A.

List of marks with "NU" used in the paint industry registered with Trade Mark Bureau of The National Paint, Varnish & Lacquer Association in its office at Washington, D. C., as testified to by Robert K. Shannon, manager of the Trade Mark Bureau (R. 96-98). (Defendant's Exhibits 101 to 128 inclusive.)

Exhibit No.

- 101 NU-BLAC registered March 10, 1919, Atlantic Varnish Works.
- 102 NU-CARTO, registered November 10, 1919, Wheeler Varnish Co.
- 103 NUECO, registered November 1, 1930, The Foy Paint Co.
- 104 NU-Eco, registered July 10, 1922, The Foy Paint Co.
- 105 NU-FINISH, registered November 9, 1923, Utley Paint Company.
- 106 NU-FLOB, registered October 28, 1908, Hockaday Paint Company.
- 107 NU-FLOB, registered April 22, 1921, Tanner Paint & Oil Co.
- 108 NU-FLOREN, registered June 29, 1922, Tanner Paint & Oil Co.
- 109 NU-O-LAC, registered December 20, 1921, Glidden Company.
- 110 NU-KAR, registered October 18, 1931, Dean & Barry Company.
- 111 NU-KOLOR-DI, registered March 13, 1918, Peaslee-Gaulbert Co.
- 112 NU-LAC, registered September 1, 1915, Sillers Varnish Co.

- 113 NU-LAC, registered May 16, 1912, Sta-Bright Mfg. Co.
- 114 LIKE NU, registered May 16, 1912, Sta-Bright Mfg. Co.
- 114 NULIFE, registered July 11, 1922, Mutual Paint Mfg. Co.
- 115 NU-LIKE, registered March 6, 1920, Asper-Martin Company.
- 116 NU LUSTRE, registered January 18, 1913, Boston Varnish Company.
- 117 NU-LYK, registered July 23, 1918, Inland White Lead Co.
- 118 NU-NAMEL, registered November 25, 1924, Utley Paint Company.
- 119 NU RINKLE, registered August 25, 1910, R. F. Johnston & Co.
- 120 NU ROOF, registered November 19, 1919, Star Paint & Varnish Company.
- 121 NU SHINE, registered September 12, 1910, Dozier & Gay Paint Company.
- 122 NU SPIRITS, registered April 2, 1919, John Briggs & Company.
- 123 NU TURPS, registered September 26, 1907, Charles H. Moore Oil Company.
- 124 NUVAR, registered January 31, 1921, Gilbert-Spruance Co.
- 125 NUWAL, registered November 12, 1914, R. F. Johnston Paint Company.
- 126 NUBELAC, registered March 1, 1923, Nubian Paint & Varnish Company.
- 127 RE-NU, registered December 16, 1908, W. W. Lawrence & Co.
- NU-TONA, registered December 16, 1908, W. W. Lawrence & Co.

128 NUWITE, registered September 6, 1910, Benj. Moore
& Co.

Mr. Milton C. Fisher, advertising manager of appellee, testified concerning the common use of "Nu" for "New" in the paint industry (R. 76-77) and that marks with "Nu" appeared on color cards and circulars advertising paints and enamels under the following names:

Defendant's Exhibits 1 to 10 inclusive.

Exhibit No.

- 1 NUWAE on paint, R. F. Johnston Paint Co.
- 2 NUSEAL, McCloskey Varnish Co.
- 3 NU-CRAFT, on Enamel, J. E. Harris Co.
- 4 NU-DA, on Flat Finish, Indianapolis Paint & Color Co.
- 5 NU KITCHEN, on Enamel.
NU-SINK, NU-STOVE, NU-LINOLEUM, Burnett Chemical Co.
- 6 NU-DA, on Wall Finish, Indianapolis Paint & Color Co.
- 7 NU-DA, on Enamel.
- 8 RENUIT, The Modern Finish, Wadsworth-Howland Co.
- 9 NU-FUN, on Enamel, Progress Varnish Co.
- 10 NU CAR TO, on One Coat Automobile Finishes, Wheeler Varnish Works.

Mr. Sappington testified that between 1915 and 1918 he saw displayed and advertised paints, varnishes and kindred articles using the word "Nu" (R. 17), among them "Nu-Back" and "Nu-Shine."

The Trade-Mark book of the National Paint, Varnish and Lacquer Association (Def's. Ex. 39) lists, on pages 90 and 91 a large number of the trade-marks and trade-names with the word "Nu," as set forth in the bill of particulars (R. 17-22) attached to defendant's amended answer.

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